

REMARKS**Claim Status**

Claims 1-34 are pending in the application. Claims 5, 8, 10, 11, 13, and 15 have been amended; claims 2, 7, and 12 have been canceled without prejudice; claims 16-34 have been added. Applicant respectfully requests reconsideration of the previously rejected claims in view of the above amendments and the arguments below.

Novelty

The Examiner rejected claims 1, 3, 5, 6, 8, 11, and 13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,852,631 to Scott ("Scott" hereinafter). According to the Examiner, Scott teaches all the limitations of the rejected claims in Abstract, Figure 1, and columns 3-6. We respectfully traverse this rejection.

Claim 1 of the instant application recites a step of "sending first information using said first values for said communication link." This step therefore takes place after the parameter values for the communication link have been determined. Claim 1 also recites the steps of "obtaining" and "adjusting"; these steps use the second information obtained in response to a result from the "sending" step. (Similar or identical limitations are recited in independent claims 6 and 11.) Thus, both "obtaining" and "adjusting" steps take place after information is sent over the link using the

initial parameter values. Scott does not teach these limitations. In particular, Scott does not teach adjusting values of link parameters in response to sending first information over the link.

Consider Scott's Figure 8, selected to appear on the face of the patent. Figure 8 shows AUTOMODE periods, TRAINING AND FAST STARTUP periods, and USER DATA transmission periods for Scott's invention; additionally, Figure 8 shows ERROR-CORRECTION NEGOTIATION periods for what Scott treats as art prior to his invention. Applicant's attorney sees no indication in Figure 8 or elsewhere in Scott that the link parameters are adjusted based on transmission of user or payload data, or another kind of information. In fact, it appears that Scott does not teach adjusting the link parameters at all. Scott appears to describe determination or exchange of initial parameters of the communication link during the periods of automatic mode synchronization and training. See, for example, col. 6, lines 28-49 and 56-65, where Scott describes how the initial physical and link layer parameters are determined. Similarly, Scott teaches establishment of the initial parameters at col. 10, lines 57-65; and at col. 11, lines 22-28. Applicant's attorney has reviewed Scott, but has not found a teaching of obtaining information regarding characteristics of the communication link and adjusting the parameters of the link based on such information.

The Examiner further rejected claims 2, 4, 7, 9, 12, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Scott. We respectfully traverse this rejection.

The Examiner has acknowledged that claims 2, 4, 7, 9, 12, and 14 include limitations not found in Scott, the sole reference. The Examiner then wrote that it would have been obvious to

adapt or modify Scott because the additional limitations of the claims are well known in the art. The Office Action does not explain, however, what would motivate a hypothetical person of ordinary skill in the art to make such adaptation. The Office Action also uses a present time frame of reference with respect to the knowledge of the additional limitations. The real issues are whether the additional limitations were known at the time the invention was made, and whether motivation to combine existed at that time.

The burden of making a *prima facie* case of obviousness rests on the Patent & Trademark Office. *E.g. In re Mayne*, 104 F.3d 1339, 1342, 41 U.S.P.Q.2d 1451 (Fed. Cir. 1997); MANUAL OF PATENT EXAMINING PROCEDURE §2142 (8th ed., rev. 1, Feb. 2003). (We will refer to sections of the manual as “MPEP § ____” hereinafter). “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” MPEP § 2143.01. Here, the Office Action does not point out any rationale found in the prior art for making the needed modifications. No “teaching, suggestion, or motivation” to make the necessary changes is offered by the Office Action. Even if we assume, *arguendo*, that the additional limitations were well known at the time the invention was made, a *prima facie* case of obviousness has not been made, because the motivation to make the modifications is completely lacking.

Claims 10 and 15 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Scott in view of U.S. Patent No. 6,571,096 to Plunkett (“Plunkett” hereinafter). It appears that the

Examiner intended this rejection to apply also to claim 5. Again, we respectfully traverse the rejection.

Similarly to the case of other claims rejected under section 103(a), the Office Action does not offer any motivation to combine the references. Without motivation to combine found in the prior art, a *prima facie* case of obviousness cannot be and has not been made.

Even more important, Plunkett does not teach hysteresis parameters for a communication link. To be sure, Plunkett does teach use of a hysteresis parameter, but Plunkett's hysteresis parameter affects switching of a wireless mobile unit from one cell to another. This is how Plunkett describes his method:

If the second zone is more preferable, the first zone is maintained [by a wireless mobile unit] within the second cell until the signal strength of the second cell exceeds the signal strength of the first cell by an amount determined by an exit parameter. At this point, the mobile unit switches to the services of the second zone.

Alternatively, after the mobile unit enters the second cell from the first cell, the mobile unit may be prevented from using services of the second zone if there is a hysteresis parameter associated with the second zone in the second cell and the mobile unit was not using services of the second zone in the first cell, before entering the second cell.

Plunkett, the Abstract.

In other words, Plunkett's hysteresis parameter affects switching from one wireless link to another wireless link. Claims 5, 10, and 15 of the present application, in contrast, recite the use of "hysteresis link parameters." (Although we believe that the claims as filed recited the hysteresis

parameters with requisite clarity, we have now amended the claims by adding the word “link” to the “hysteresis parameter” expression, to make this point even more clear.)

Note also that each of the claims 5, 10, and 15 depends from an intermediate claim that recites that the step of “adjusting” is responsive to interference between two links. (Those intermediate claims are claims 3, 8, and 13, respectively.) Thus, in accordance with claims 5, 10, and 15 the two links are used concurrently; otherwise there would be no interference. In Plunkett, a wireless mobile unit switches from one link to another. The links are active at different times – a link in one cell is dropped when a link in another cell is established. Therefore, adding Plunkett’s limitation would result in inability to perform the “adjusting” step as limited by claims 3, 8, and 13.

New Claims

Dependent claims 16 through 34 have been added to claim additional aspects of the invention. These claims are patentable over Scott for the reasons discussed above in relation to claim 1, from which the newly-added claims depend, and because these claims recite additional limitations, such as inclusion of specific link parameters, obtaining specific transmission information, and adding backhaul connectivity to a non-wireless network.

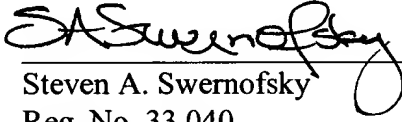
CONCLUSION

For the foregoing reasons, the Applicant respectfully submits that all pending claims are patentable over Scott and Plunkett. To discuss any matter pertaining to the instant application, the Examiner is invited to call the undersigned attorney at (650) 947-0700.

Having made an effort to bring the application in condition for allowance, a timely notice to this effect is earnestly solicited.

Respectfully submitted,

Dated: 12-15-2003


Steven A. Swernofsky
Reg. No. 33,040

The Swernofsky Law Group
P.O. Box 390013
Mountain View, CA 94039-0013
(650) 947-0700